

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAU-GEE CHEN
and
CHIEH-CHIH LI

Appeal No. 1997-3424
Application No. 08/510,740

ON BRIEF

Before KRASS, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on a request by the Examiner that we reconsider our decision of August 15, 2001 wherein we reversed the Examiner's rejection of claims 1-4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner presents several arguments in the request which assert grounds for reversing our decision of August 15, 2001.

Appeal No. 1997-3424
Application No. 08/510,740

We have reconsidered our decision of August 15, 2001 in light of the Examiner's comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any substantive changes in our prior decision for the reasons which follow.¹

At the outset, we consider the argument made by Appellants in their reply to the Examiner's request for reconsideration (Paper No. 24, filed November 15, 2001) which asserts a lack of statutory basis for permitting an Examiner to request reconsideration of a decision of the Board of Appeals. In Appellants' view, the Manual of Patent Examining Procedure (MPEP) § 1214.04, which suggests that the Examiner may request rehearing of a Board decision, is in conflict with 37 CFR § 1.197(b) which provides for a request for rehearing only by an Appellant. According to Appellants, " . . . since the MPEP is not adopted pursuant to the Patent Office's rule making authority granted under 35 U.S.C. § 6 and 5 U.S.C. § 553, the MPEP carries no weight." (Id. at page 1).

¹ In formulating this decision on the Examiner's request for rehearing, we are mindful of the comments filed by Appellants in a paper entitled "APPLICANT'S [sic, APPLICANTS'] SUPPLEMENTAL REPLY TO THE EXAMINER'S SUPPLEMENTAL ANSWER" filed July 23, 2001 (Paper No. 25). We did not have the opportunity to consider such paper at the time of our original decision since it was not associated with the application file until after the August 15, 2001 date of our original decision.

Appeal No. 1997-3424
Application No. 08/510,740

We do not find this argument of Appellants to be persuasive. The provision in 37 CFR § 1.197(b) allowing for requests for rehearing of a Board decision by an Appellant is a permissive one. We find no provisions in the rules which prohibit an Examiner from also requesting a rehearing of a decision by the Board. Further, the courts have long sanctioned the filing of requests for rehearing by Examiners. In In re Schmidt, 377 F.2d 639, 641, 153 USPQ 640, 642 (CCPA 1967), the court quoted from a decision of the Commissioner, issued in response to a petition for vacation of the Board decision by the Appellants in that case, which stated in part:²

While requests for reconsideration by examiners are rare, it has been the settled practice to entertain them if circumstances justify them, as they appear to have done in the present case. To refuse to consider such requests would result in the anomalous situation that the Board would be powerless to correct any error in the appellant's favor, although it could correct errors militating against the appellant. It is not considered that the procedure in this case is contrary to any applicable rule or statute.

The court went on to state:

It is the duty of the Patent Office to satisfy itself in the first instance that the statutory requirements pertaining to the obtaining of

² See also In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 33 (CCPA 1974).

Appeal No. 1997-3424
Application No. 08/510,740

patents have been met. We are aware of no authority, and appellants cite none, which precludes the Patent Office from retaining jurisdiction in the prosecution of applications and correcting what it considers to be mistakes in its decisions, until the time for judicial review has expired or a patent has issued. [Id., 377 F.2d at 642, 153 USPQ at 642.]

We also note that the Schmidt decision was cited with approval in In re Alappat, 33 F.3d 1526, 1533, 31 USPQ2d 1545, 1548 (Fed. Cir. 1994).

As to the merits of the Examiner's request, the Examiner initially contends that our original decision failed to analyze the claimed invention according to the principles set forth in State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998), cert. denied, 119 S.Ct. 851 (1999). Contrary to the Examiner's contention, however, our original decision clearly indicated that the principles espoused in State Street were being followed in analyzing the claimed subject matter. (Decision, page 6). While the Examiner found (Supplemental Examiner's Answer, page 2) that the quotient produced by the implementation of the claimed steps did not produce a "useful, concrete and tangible result," we reached the opposite conclusion. We find no error in the determination in our original decision that, when the process

steps involved in the claimed division operation are tied to implementation on a digital processing system such as a computer, a "useful, concrete and tangible" result is produced. As pointed out in Appellants' disclosure (specification, pages 1-4), the sequential operations involved in performing division operations represent one of the most complex and time consuming functions performed in digital processing computer systems. That a "useful, concrete and tangible result" is produced when a technique for performing a division operation in a simpler, more efficient manner, with the attendant increase in computer processing speed and efficiency when implemented on a computer system as presently claimed is, in our view, undeniable. We also find, for the reasons discussed supra, the determination we reached in our original decision to be in accord with the decision in AT&T Corp. v. Excel Communs., Inc., 172 F.3d 1352, 1360, 50 USPQ2d 1447, 1453 (Fed. Cir.), cert denied, 528 U.S. 946 (1999) which asked the question whether a claimed algorithm "is applied in a practical manner to produce a useful result."

We do not dispute the Examiner's further argument that " . . . the issue is not whether or not the process is performed by a computer but rather whether or not the process produces a useful, concrete, tangible result." (Request, page 2, Examiner's

emphasis). It is equally true, however, that the claimed implementation of a process involving calculations or a mathematical algorithm on a particular machine, a computer in this case, can not be ignored in determining whether a useful result is produced. In our opinion, it is precisely this claimed integration of the process steps with a computer system that removes the process from the realm of " . . . merely abstract ideas constituting disembodied concepts or truths that are not 'useful.'"³

We also do not find to be persuasive the Examiner's further contention that, unlike the Court's finding in State Street, the calculated quotient in Appellants' invention is only a number without significance or meaning. In our view, this is an overly restrictive interpretation of the principles articulated in State Street. The Examiner is correct that the State Street court found the calculated number, which represented a share value, to have a real world significance, and concluded that the calculations therefore produced a useful result given that particular factual situation. We find no support, however, in this decision, or any other, for the Examiner's implied

³ See State Street Bank, 149 F.3d at 1373, 47 USPQ2d at 1600-01.

suggestion that a calculated number produced as a result of a series of process steps is required to have significance or "meaning," regardless of how such process steps may be implemented in a particular claimed system. Similarly, we find the Examiner's proposed example directed to the solution of an equation to have little probative value on determining the issue on appeal. Clearly, Appellants' claims are not directed to merely solving an equation. At best, Appellants' claimed division technique is related to the solution of an equation only in the sense that it may enable a digital processing system to solve such an equation faster and more efficiently. We are hard-pressed to appreciate how such would not be a "useful" result.

Lastly, we address the Examiner's implied concern in the Request that our original decision could be interpreted as establishing a "per se" rule for determining patentability issues related to computer implemented processes. We are firmly of the belief that "per se" rules are of little guidance in deciding patentability issues of any nature with respect to a particular factual situation that might be presented. To whatever extent our original decision might be misinterpreted as promulgating

Appeal No. 1997-3424
Application No. 08/510,740

such a blanket rule for determining the patentability of computer implemented processes, we take this opportunity to forcefully dispel that notion.

We have granted the Examiner's request to the extent that we have reconsidered our decision of August 15, 2001, but we deny the request with respect to making any substantive changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).


REHEARING/DENIED



ERROL A. KRASS)
Administrative Patent Judge)



JOSEPH F. RUGGIERO)
Administrative Patent Judge)



HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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Appeal No. 1997-3424
Application No. 08/510,740

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Appeal No. 1997-3424

Serial No. 08/510,740

Harry

March 22, 2002

~~Judge Ruggiero~~

3. ~~Judge Blankenship~~

2. ~~Judge Krass~~

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p. 2 Harry
p. 3 Harry

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*Reminder for ACTS, the examiner is requesting rehearing, not the appellants.